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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/523,180	10/14/2005	Herbert Koch	Muller-48	8318

7590

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EXAMINER

TESKIN, FRED M

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/523,180

Applicant(s)

KOCH ET AL.

Examiner

Fred M. Teskin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-8, 11 and 16 is/are allowed.
- 6) ☒ Claim(s) 9, 10 and 12-15 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 052305.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

The preliminary amendment of January 28, 2005, has been entered in full.

Claims 1-16 are currently pending and under examination.

Claims 9, 10, 12, 13 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). In the present instance, claim 9 recites the broad recitation "1 to 12 carbon atoms", and the claim also recites "particularly 4 to 6" which is a narrower statement of the range/limitation. Similarly, claims 10, 12 and 13 each contain broad and narrower statements of the same range/limitation (in the same claim); while claim 15 broadly calls for producing "silencing materials and/or tires"

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followed by “particularly winter tires ..., preferably tire treads,” which is a narrower statement of the article to be produced.

Claims 14 and 15 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The expression “Polymerisates *obtainable* according to ...” renders claim 14 (and claims dependent thereon) indefinite because almost any variation in any parameter within the scope of the claimed process would alter the polymer produced. In consequence, one who made or used a polymer made by a process other than the process recited in claim 1 or 2 would have to produce polymers using all possible parameters within the scope of the claim – a practical impossibility – and then extensively analyze each product to determine if his product was *obtainable* by a process within the claimed process. A claim is indefinite if undue experimentation is involved to determine the boundaries of protection. *Ex parte Tanksley*, 26 USPQ2d 1389. This rationale is applicable to the present case in view of the extensive testing that would be involved in ascertaining whether a polymer made by a process different to that claimed is nevertheless *obtainable* by the claimed process. Amending claim 14 by replacing “obtainable” with –obtained– would obviate this ground of rejection.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14 and 15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over US 5008343 to Hellermann et al or US 3294768 to Wofford.

Each of the citations exemplifies polymerizates of butadiene-styrene copolymer, which are characterized by a microstructure and block polystyrene (or wt. % polystyrene) content commensurate with the corresponding parameters of applicants' polymer as reported in, e.g., specification Table 1. See in particular Table 1, Examples 1, 2 and 5-9 of Hellermann et al; and Wofford at Table 1, runs 1-8 and Table VI, runs 1-6. Use of the copolymers as anti-vibration (i.e., silencing) elements and/or tire components is specifically taught: Hellermann et al, column 1, ll. 10-16 and column 5, lines 49+; Wofford, column 1, ll. 41-45 and column 7, ll. 10-21.

Although Hellermann et al and Wofford prepare butadiene-styrene copolymers by an anionic polymerization procedure different to the present invention, the similarity of

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the mutually disclosed properties and copolymer compositions provide a plausible basis for concluding that the instantly claimed polymerisates are the same as, or unobviously different from, the patentees'.

Where, as here, a product-by-process claim is rejected over a prior art product that appears to be identical, although produced by a different process, the burden properly shifts to applicants to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. *In re Marosi*, 218 USPQ 195 (Fed. Cir. 1983). This is especially true given the lesser burden of proof on the Office in making out a case of *prima facie* obviousness for product-by-process claims, because of their peculiar nature (M.P.E.P. 2113).

The prior art made of record and not relied upon is considered pertinent to applicants' disclosure.

Brockhuis is pertinent to the production of elastomeric copolymer of styrene and butadiene by anionic polymerization in the presence of s-butyllithium and ethyleneglycol di-n-butylether. Polymerization in the presence of an alkali metal alcoholate is not contemplated.

Claims 1-8, 11 and 16 are allowable on the present record.

The following is a statement of reasons for the indication of allowable subject matter: The claimed process of producing polymerisates by anionic polymerization in

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the presence of at least one lithium-organic compound and dialkyl ether of defined formula and by use of an alkali metal alcoholate as more specifically defined in claim 1, in quantities from greater than 0.5 mol/mol of lithium in the lithium-organic compound, is not taught nor fairly suggested in the available prior art.

Any inquiry concerning this communication should be directed to Examiner F. M. Teskin whose telephone number is (571) 272-1116. The examiner can normally be reached on Monday through Thursday from 7:00 AM - 4:30 PM, and can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu, can be reached on (571) 272-1114. The appropriate fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

FMTeskin/03-05-06


FRED TESKIN
PRIMARY EXAMINER
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